

REMARKS

Applicant respectfully thanks the Examiner for the consideration provided to this application, and respectfully requests reconsideration of this application.

Each of claims 1, 13, 43, and 44 has been amended for at least one reason unrelated to patentability, including at least one of: to explicitly present one or more elements, limitations, phrases, terms and/or words implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claims 1-44 and 46 are now pending in this application. Each of claims 1, 43, and 44 is in independent form.

I. The Anticipation Rejections

Each of claims 1, 20, 43, and 44 was rejected as anticipated, and thus unpatentable, under 35 U.S.C. 102(b). In support of the rejection, various portions of U.S. Patent 7,020,876 (“Deitz”) were applied. These rejections are respectfully traversed as moot in view of the present amendments to each of claims 1, 43, and 44.

Specifically, each of claims 1, 43, and 44, from one of which claim 20 ultimately depends, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Dietz teach, “based upon an **automatically detected hierarchy** among elements of the configuration information”, “**automatically obtaining**”, “a first transformed version of the configuration information”.

In addition, each of claims 1, 43, and 44, from one of which claim 20 ultimately depends, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Dietz teach, “generating”, “via a first set of instructions encoded in DHTML”, “a graphical user interface based on an automatically detected hierarchy among elements of the first transformed version of the configuration information”.

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In addition, each of claims 1, 43, and 44, from one of which claim 20 ultimately depends, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Dietz teach, “the user input indicative that a second set of DHTML instructions are to be applied to obtain the second transformed version of the configuration information”.

For at least these reasons, it is respectfully submitted that the rejection of claims 1, 43, and 44 is unsupported by Dietz and should be withdrawn. Also, the rejection of claim 20, ultimately depending from one of independent claims 1, 43, or 44, is unsupported by Dietz and also should be withdrawn.

II. The Obviousness Rejections

Each of claims 2-19, 21-42, and 46 was rejected under 35 U.S.C. 103(a) as being obvious, and thus unpatentable, over various combinations of U.S. Patent 7,020,876 (“Deitz”), U.S. Patent 6,996,589 (“Jayaram”), U.S. Patent 6,289,266 (“Payson”), U.S. Publication 2001/0047420 (“Talanis”), a paper, John Mylopoulos, Huaiqing Wang, and Bryan Kramer, “Knowbel: A Hybrid tool for building expert systems”, IEEE, February 1993, (“Mylopoulos”), U.S. Patent 20010056429 (“Moore”), U.S. Publication 2002/0026633 (“Koizumi”), U.S. Publication 2002/0077711 (“Nixon”), U.S. Publication 2002/0055804 (“Betawar”), and/or portions of the book “Yahoo For Dummies” (“Hill”). Each of these rejections is respectfully traversed.

A. Legal Standards

1. Overview of *Prima Facie* Criteria for an Obviousness Rejection

The Patent Act, namely, 35 U.S.C. 103, forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.”

Relatively recently, in *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007), the Supreme Court interpreted this law while highlighting the typical invention process.

“**Inventions** usually rely upon building blocks long since uncovered, and claimed discoveries **almost necessarily will be combinations** of what, in some sense, is already known” (emphasis

added). Yet, to properly apply §103, the Court recognized the need to filter, via obviousness analyses, true inventions from mere ordinary technological advances. “Granting patent protection to advances that **would occur in the ordinary course** without real innovation retards progress and may, in the case of patents combining previously known elements, deprive prior inventions of their value or utility” (emphasis added).

Obviousness is a legal question based on underlying factual findings. *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000). In *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court established factors regarding the factual inquiry required to establish obviousness. The factors include:

1. determining the scope and contents of the prior art;
2. ascertaining differences between the prior art and the claims at issue;
3. resolving the level of ordinary skill in the pertinent art; and
4. considering objective evidence indicating obviousness or nonobviousness.

Thus, factual determinations include, *inter alia*, the scope and content of the prior art, the level of skill in the art at the time of the invention, the objective evidence of nonobviousness, the presence or absence of a reason to combine, and whether a reference constitutes analogous prior art. See *In re Biggio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004); *Gartside*, 203 F.3d at 1316; *Para-Ordinance Mfg. v. SGS Imps. Int'l.*, 73 F.3d 1085, 1088 (Fed. Cir. 1995); *In re GPAC, Inc.*, 57 F.3d 1573, 1577 (Fed. Cir. 1995). “What the prior art teaches and whether it teaches toward or away from the claimed invention also is a determination of fact.” *Para Ordinance Mfg.*, 73 F.3d at 1088 (*citing In re Bell*, 991 F.2d 781, 784 (Fed. Cir. 1993)).

KSR warned that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art”. Instead, “[i]n determining whether the invention as a whole would have been obvious under 35 U.S.C. 103, we must first delineate the invention as a whole. In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question... but also to those properties of the subject matter which are inherent in the subject matter and are disclosed in the specification. . . Just as we look to a chemical and its properties when we examine the obviousness of a composition of matter claim, it is this invention **as a whole**, and not some part of it, which must be obvious under 35 U.S.C. 103.” *In re Antonie*, 559 F.2d 618, 620, 195 USPQ

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6,8 (CCPA 1977) (emphasis in original).

Regarding proposed combinations of prior art, *KSR* clarified that the “[t]he question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art”. Thus, in determining obviousness, both *KSR* and *Graham* warned against a “temptation to read into the prior art the teachings of the invention in issue” and instruct to ““guard against slipping into the use of hindsight”“.

To guard against hindsight, *KSR* explained the “import[ance]” of “identify[ing] **a reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**” (emphasis added). That is, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some **articulated reasoning** with some rational underpinning to support the legal conclusion of obviousness” (*quoting In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006) (emphasis added)). Thus, “[t]o facilitate review, this analysis should be made explicit”.

Explaining the need for “**a reason that would have prompted** a person of ordinary skill”, *KSR* further taught that “if a **technique** has been used **to improve** one device, and a person of ordinary skill in the art **would recognize** that it would improve similar devices in the same **way**, using the technique is obvious unless its actual application is beyond his or her skill” (emphasis added). Further exploring this mandate, the Federal Circuit has held that “knowledge of a problem and motivation to solve it are entirely different from motivation to combine particular references”. *Innogenetics v. Abbott Laboratories* (Fed. Cir. 2007-1145) (8 January 2008).

Thus, according to the Supreme Court, a proper obviousness rejection must “identify **a reason that would have prompted** a person of ordinary skill in the relevant field **to combine** the elements **in the way the claimed new invention does**” and must present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination. It follows that if the alleged reason for making the particular combination of features is not evidenced to be art-recognized, then that reason **must be** based on hindsight.

In addition to establishing a proper reason to combine, a proper obviousness rejection must clearly identify proposed reference(s) that:

1. are pertinent;
2. provide a reasonable expectation of success; and
3. teach... all the claim limitations

See MPEP 2143; MPEP 2143.03, *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); and additional citations *infra*.

The Federal Circuit has further held that “[w]hen there is a design need or market pressure to solve a problem”, obviousness is not supported unless “a finite, and in the context of the art, small or easily traversed, number of options” “**would** convince an ordinarily skilled artisan of obviousness”. *Ortho-McNeil Pharmaceutical Inc. v. Mylan Laboratories Inc.*, 520 F.3d 1358 (Fed. Cir. 2008).

Consistent with other patentability rejections, to establish a *prima facie* case of obviousness, substantial evidence must be provided that fulfills the mandates of the applicable law. The “Patent Office has the initial duty of supplying the factual basis for its rejection.” *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057, *reh'g denied*, 390 U.S. 1000 (1968). “It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis”. *Id.*

It is legal error to “substitute[] supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results.” *See, In re Ochiai*, 71 F.3d 1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1998); *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

“Once the examiner... carries the burden of making out a *prima facie* case of unpatentability, ‘the burden of coming forward with evidence or argument shifts to the applicant.’” *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (*quoting In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

2. Claim Construction

Before the *prima facie* obviousness criteria can be applied, the words of each claim must be interpreted. The Federal Circuit, in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) (*en banc*), *cert. denied*, 546 U.S. 1170, 126 S.Ct. 1332, 164 L.Ed.2d 49 (2006) clarified that:

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1. “[t]he Patent and Trademark Office (‘PTO’) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction **‘in light of the specification as it would be interpreted by one of ordinary skill in the art’**” (*Id.* at 1316);
2. the words of a claim “are generally given their ordinary and customary meaning” (*Id.* at 1312);
3. the ordinary and customary meaning of a claim term is “the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application” (*Id.* at 1313);
4. “the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but **in the context of the entire patent**, including the specification” (*Id.*);
5. even “the context in which a term is used in the asserted claim can be highly instructive” (*Id.* at 1314);
6. “the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, **the inventor’s lexicography governs**” (*Id.* at 1316);
7. even “when guidance is not provided in explicit definitional format, **the specification may define claim terms by implication** such that the meaning may be found in or ascertained by a reading of the patent documents” (*Id.* at 1321);
8. an “invention is construed not only in the light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office” (*Id.* at 1317 (*citing Graham v. John Deere Co.*, 383 U.S. 1, 33 (1966))); and
9. the “prosecution history... consists of the complete record of the proceedings before the PTO and **includes the prior art cited** during the examination of the patent” (*Id.* at 1317).

The rules established in *Phillips* apply to *ex parte* examination in the USPTO. *See, In re Kumar*, 418 F.2d 1361 (Fed. Cir. 2005).

3. Unfounded Assertions of Knowledge

Deficiencies of the cited references can not be remedied by general conclusions about what is basic knowledge or common sense to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001). An assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* That is, such unfounded assertions are not permissible substitutes for evidence. *See, In re Lee*, 277 F.3d 1338, 1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002).

4. The Applied Reference(s) Must Present All Claim Limitations

“To establish a *prima facie* case of obviousness... the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP 2143.

The proposed modification or combination must provide the structure recited in the claims and produce the result attained by that structure. *See In re Schulpen*, 390 F.2d 1009 (C.C.P.A., 1968).

5. The Applied Reference(s) Must Be Enabling

“In order to render a claimed apparatus or method obvious, the prior art must **enable** one skilled in the art to make and use the apparatus or method.” *Rockwell Int'l Corp. v. U.S.*, 147 F.2d 1358, 47 USPQ2d 1027 (Fed. Cir. 1998); *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1471, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997); *Beckman Instruments, Inc. v. LKB Produkter AB*, 892 F.2d 1547, 1551, 13 USPQ2d 1301, 1304 (Fed. Cir. 1989); *In re Johnston*, 435 F.3d 1381 (Fed. Cir. 2006).

6. Next Office Action

If an Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the applied reference will necessarily be factually based on an entirely different portion of that reference, and thus will be legally defined as a “new grounds of rejection.” Consequently, any Office Action containing such rejection can not properly be made final. *See, In re Wiechert*, 152 USPQ 247, 251-52 (CCPA 1967) (defining “new ground of rejection” and requiring that “when a rejection is factually based on an entirely

different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference”), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967) (the USPTO “has the initial duty of supplying the factual basis for its rejection”).

B. Analysis

1. Claims 2-19, 21-42

Claim 1, from which each of claims 2-19 and 21-42 ultimately depends, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the cited references teach (i.e., disclose and/or enable), alone or in combination, “based upon an **automatically detected hierarchy** among elements of the configuration information”, “**automatically obtaining**”, “a first transformed version of the configuration information”.

In addition, claim 1, from which each of claims 2-19 and 21-42 ultimately depends, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the cited references teach (i.e., disclose and/or enable), alone or in combination, “generating”, “via a first set of instructions encoded in DHTML”, “a graphical user interface based on an automatically detected hierarchy among elements of the first transformed version of the configuration information”.

In addition, claim 1, from which each of claims 2-19 and 21-42 ultimately depends, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the cited references teach (i.e., disclose and/or enable), alone or in combination, “the user input indicative that a second set of DHTML instructions are to be applied to obtain the second transformed version of the configuration information”.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in modifying the applied portions of reference relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented that the applied portions of the reference relied upon in the Office Action, **as attempted to be modified**, expressly or inherently teach every limitation of claim 1 (and thereby any of claims 2-19 and 21-42, which depend from claim 1), and the Office Action consequently fails to establish a *prima*

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facie case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

CONCLUSION

It is respectfully submitted that the application is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account 19-2179. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,



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